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Confirmation No.: 1590

Filed: 27 March 2001

For: ROLL GOODS DISPENSER SYSTEM AND METHODS OF USE

Applicants traverse this rejection and submit that claims 1-32 meet the requirements of 35 U.S.C. § 112, first paragraph. The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. *See In re Buchner*, 18 U.S.P.Q.2d 1331, 1332 (Fed. Cir. 1991). A patent need not teach, and preferably omits, what is well known in the art. *See id.*

Further, in order to make the rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 27 U.S.P.Q.2d 1510, 1513 (Fed. Cir. 1993). A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. *See* M.P.E.P. § 2164.04. "[I]t is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement." *In re Marzocchi*, 169 U.S.P.Q. 367, 370 (C.C.P.A. 1971). Applicants submit that the Office Action has not met this burden.

Here, one skilled in the art would be able to determine how the side shields are movable from the closed configuration to the open configuration without undue experimentation based in part upon the Specification and drawings of the present invention. For example, FIGS. 1 and 3 depict one embodiment of a roll goods dispenser system where the side shields are in a closed configuration, and FIG. 2 depicts the side shields in an open configuration. The side shields 22 and 32 may be biased in either the closed or open configuration, whereby a force is required to move the side shields 22 and 32 between the open configuration and the closed configuration. *See* Specification, page 7, lines 3-6. Placing the system 10 in the open configuration may include exerting a force on side shield 22 first, followed by exerting a force on side shield 32; or a force

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may be exerted on both sides shields 22 and 32 simultaneously. *See* Specification, page 8, line 31 through page 9, line 2.

The shields may then be returned to the closed configuration by closing the first side shield 22 followed by the second side shield 32, or both sides shields may be closed simultaneously. *See* Specification, page 9, lines 6-8. In some instances, the side shields 22 and 32 may be closed by first placing the roll goods dispenser system 10 on a flat surface with side shield 22 laid flat on the surface, and then exerting a force on the side shield 32 such that the force returns the side shield 32 directly to the closed position, and returns the side shield 22 to the closed position by compressing the system 10 against the flat surface. *See* Specification, page 9, lines 9-14.

Further, the types of materials used in the present invention as described in the Specification further illustrate to one of skill in the art how the side shields are movable from the closed configuration to the open configuration. For example, the side shields may be made of any suitable material, including SANTOPRENE, made by Advanced Elastomer Systems, L.P. of Akron, OH; rubber; ULTRATHANE UE 630 Nat., made by Futura Coatings, Inc. of St. Louis, MO; DOWLEX 2517 Nat., made by Dow Chemical Co. of Midland, MI; SARLINK 3180 Nat., made by DSM Thermoplastic Elastomers, Inc. of Leominster, MA; and urethane. *See* Specification, page 6, lines 11-17.

Therefore, one skilled in the art would be able to determine how the shields are movable between the closed and open configurations based in part on the figures and specification of the present invention.

For at least the above reasons, Applicants submit that claims 1-32 meet the requirements of 35 U.S.C. § 112, first paragraph. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

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Drawings Objection

The drawings were objected to under 37 C.F.R. § 1.83(a) as not showing every feature of the invention specified in the claims. Specifically, the Office Action alleges that the subject matter of claim 6 is not shown in the drawings. Applicants traverse this objection.

Applicants submit that the figures of the present invention illustrate the elements of claim 6. For example, claim 6 recites that the retaining plug of the first dispenser guard is attached to the retaining plug of the second dispenser guard. Figures 2 and 3, for example, illustrate retaining plug 24 of dispenser guard 20 as being attached to retaining plug 34 of dispenser guard 30. Therefore, Applicants submit that the drawings of the present invention do show every feature of claim 6. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

The 35 U.S.C. § 112, Second Paragraph, Rejection

Claims 1-32 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Office Action alleges that the terms "convex" and "concave" are used to describe objects that do not fit these definitions (according to Webster's New World Dictionary, Third College Edition).

Applicants traverse this rejection and submit that claims 1-32 meet the requirements of 35 U.S.C. § 112, second paragraph. For example, claim 1 recites that the side shield in the closed configuration forms a concave shape facing the roll. Applicants submit that this meaning of the term "concave" is not repugnant to the plain meaning of the word. Applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the term's well known usage. *In re Hill*, 73 U.S.P.Q. 482 (C.C.P.A. 1947).

Further, Applicants submit that the plain meaning of the word "concave" describes the side shield in the closed configuration. The term "concave" is defined as "hollow and curved like the inside of a bowl." *Webster's New World College Dictionary*, 3rd Ed., page 287 (1997) (attached herewith as Exhibit A). Accepting such definition, the side shield as shown, e.g., in

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FIG. 3, has a concave shape facing the roll. In other words, the shape of the side shield as you look at the side shield from the perspective of the roll has a concave shape "like the inside of a bowl."

Further, claim 1, for example, recites that the side shield in the open configuration forms a convex shape facing the roll. The term "convex" is defined as "curving outward like the surface of a sphere." *Webster's New World College Dictionary*, 3rd Ed., page 305 (1997) (attached herewith as Exhibit A). As viewed from the roll, the side shield 20 in the open configuration forms a convex shape because it curves outward from the roll. See, e.g., FIG. 2. Therefore, one of ordinary skill in the art would understand what is claimed in light of the specification, figures, and plain meaning of the language of the claims. See M.P.E.P. § 2173.05(b).

For at least the above reasons, Applicants submit that claims 1-32 meet the requirements of 35 U.S.C. § 112, second paragraph. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

The 35 U.S.C. § 103 Rejection

Claims 1-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Bishop (U.S. Patent No. 474,518).

Applicants traverse this rejection and submit that claims 1-32 are not *prima facie* obvious in view of Bishop for at least the following reasons. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

Claims 1-32 are not *prima facie* obvious because Bishop does not teach all of the elements of such claims. For example, claim 1 recites that the side shield is movable between a closed configuration and an open configuration. In contrast to claim 1, Bishop teaches that a

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covering-strip D of a width equal to the length of the completed case is wound around over the flanges "a" and is glued or pasted to the end pieces AA to hold the several parts together. *See* Bishop, page 1, lines 70-77. In other words, Bishop teaches that the end pieces AA are held together by covering-strip D and are not free to be moved into an open configuration as is recited in claim 1. Therefore, Bishop does not teach all of the elements of claim 1.

Further, modifying Bishop in the manner suggested by the Office Action would render the device taught by Bishop unsatisfactory for its intended purpose. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *See In re Gordon*, 7221 U.S.P.Q. 1125 (Fed. Cir. 1984). The Office Action alleges that end pieces AA of Bishop "can be removed from the core and positioned with the outside walls facing the roll therefore forming a convex shape facing the roll." Applicants first note that there is no motivation or suggestion given in the prior art to make such a modification in Bishop. Further, turning one or both end pieces AA around would leave the ribbon exposed to external elements and possible damage. This is in direct contrast to the teachings of Bishop, where the case is "designed to furnish a neat package for the ribbon, to completely protect it from damage, rough handling or the oxidizing effect of the atmosphere." *See* Bishop, page 1, lines 7-10. Turning one or both end pieces around would, therefore, render Bishop unsatisfactory for its intended purpose of protecting ribbon from damage and oxidation.

For at least the above reasons, Applicants submit that claims 1-32 are not *prima facie* obvious in view of Bishop. Reconsideration and withdrawal of this rejection are, therefore, respectfully requested.

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Summary

It is respectfully submitted that the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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By

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CERTIFICATE UNDER 37 C.F.R. § 1.8:

The undersigned hereby certifies that this paper is being transmitted by facsimile in accordance with 37 C.F.R. § 1.6(d) to the Patent and Trademark Office, addressed to Assistant Commissioner for Patents, Washington, D.C. 20231, on this 5th day of September, 2002, at 4:43pm (Central Time).

By: Rachel Gayland-GibsonName: Rachel Gayland-Gibson